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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/782,794

Confirmation No.: 6789

In re Application of

Group Art Unit: 1661

Mark Roland BOEDER

Examiner: Anne Marie Grünberg

Filed: February 23, 2004

For: CHRYSANTHEMUM PLANT NAMED 'CETWOTONE PINK'

REPLY TO REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicant replies to the requirement for information under 37 CFR 1.105 mailed April 21, 2005 as follows.

Applicant initially disagrees absolutely with the rationale stated in the second full paragraph on page 1 of the requirement. The law, both before and after In re Elsner, did not authorize a rejection under 35 USC 102 based upon a non-enabling PBR publication and knowledge of the breeder's address, website, or telephone number. To the extent that any such rejection may be

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based upon the stated rationale, applicant respectfully submits that such a rejection is supportable neither in law nor in acceptable public policy.

Applicant replies to the matters specifically requested thusly:

As to what was sold abroad more than one year prior to the United States patent application, the Examiner is informed that 'Cetwotone Pink' is usually grown as a cut mum. Flowering stems, including flowers and foliage in this product group, are sold at the Dutch auction.

As to point b), sale has occurred regularly in the Netherlands under the commercial name 'Twotone Pink' rather than under the name 'Cetwotone Pink,' the denomination for PBR registration. The denominations are named differently.

As to c), a breeder's reference is used in the PBR papers during the initial phase of registration during the initial registration phase prior to the grant of a PBR title. The assignee never discloses information regarding varieties under registration to third parties regardless of how the plant is denominated in those initial papers.

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As to d), applicant maintains that the essence of the invention is the creation of the variety 'Cetwotone Pink,' which can only be reproduced upon receipt of information regarding the parentage from the CPVO, which, in the instant case, is possible only after acceptance of the denomination proposal and publication on April 15, 2004, almost two months after the U.S. filing date.

As to e), the CPVO website permits public access to a summary of the PBR register, including file number, application date, breeder reference, code of examination office, and code of applicant. For the instant variety, such a summary for public access became available on February 15, 2002 upon publication of the application. At that time, the plant is identified only by breeder reference and a person of ordinary skill in the art could not make an association between the breeder's reference and the indicated denomination. The earliest date that the denomination was proposed was February 25, 2003. If a third party wants to obtain additional information regarding the whole file, including a technical questionnaire, a third party has to send a written request to the CPVO office, all of which would take place after April 15, 2004, post U.S. filing.

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The USPTO website describes in a section regarding general information on plant patents that there are two steps constituting an invention in plant applications in the United States, namely invention of the new variety and its subsequent asexual reproduction.

PBR documents submitted for applications in the Netherlands and the CPVO contain information regarding the mode of propagation. Access to such parts of registered files will reveal how to produce the plant itself but those files standing alone are not enabling.

As to creation of a new variety, one is able to reproduce same when the parentage of the crossing is known.

Enclosed are copies of recent letters from the Dutch and CPVO plant protection offices showing that the two institutes differ in their policy of providing confidential information regarding the parentage of the crossing to the general public. While the plant is included in the public registers of the Dutch and CPVO offices, not all information on this variety is readily available. The Dutch office does not disclose essential parts of the register, including all information on parentage of a relevant variety. Thus, registration in the Dutch PBR office in combination with

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public availability of the plant material cannot be considered a disclosing act. Without knowledge of the plant parentage, one cannot reproduce the plant.

The Examiner is directed particularly to two portions of the May 3, 2005 letter from the Dutch PBR. The second paragraph under Ad a contains the sentence, "The Board for Plant Breeders' Rights will not inform third parties about the breeding history without authorization of the applicant or his successor in title." In Ad b (discussing data obtained during official examination), the writer explains that while "third parties can obtain descriptions of the registered varieties," third parties, as a result of such description, "are not informed about the breeding histories."

The CPVO office will grant a request for insight information for justified reasons only. Information regarding the parentage of the plant could be obtained from the CPVO in a late stage of the registration, namely after the denomination proposal has been made. (See last paragraph of the May 10, 2005 letter regarding CPVO policy or access to information regarding parents of varieties.)

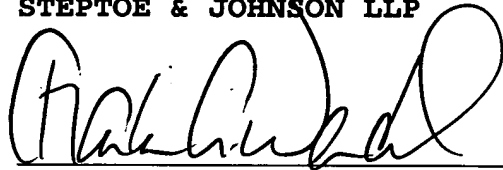
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Applicant continues to rely upon the arguments for patentability in the Amendment Under 37 CFR 1.111 filed January 24, 2005; see particularly the paragraph bridging pages 3 and 4 of that paper.

Favorable treatment of the application is earnestly solicited.

Respectfully submitted,

STEPTOE & JOHNSON LLP



Charles A. Wendel  
Registration No. 24,453

June 2, 2005

Date

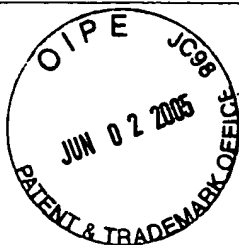
CAW/dwj

Enclosures:

Copies of letters from Dutch PBR Office and CPVO

Attorney Docket No. 28967.0178 (Old: CHRE:178)

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CBA Research B.V.  
t.a.v. Mevr. Y. Fung  
Postbus 370  
1430 AJ AALSMEER

ONTVANGEN 06 MEI 2005

Ede, 03-05-2005

Your Letter of :  
Your reference :  
Our reference : 2005062  
Subject : **Breeding history**

Dear Mrs. Fung,

Answering your question about the policy of the Board for Plant Breeders' Rights in the Netherlands concerning the access to the breeding history of varieties, I inform you as follows.

As far as information concerning varieties is concerned one should make a distinction between

- Information by the breeder in order to facilitate the examination of the application for PBR, mostly given in the technical questionnaire (TQ) attached to the application form;
- Data gained from the official examination in order to describe the variety.

Ad a

The breeder's information (which is not per se correct) is used to compare the candidate variety with the proper reference varieties. Prominent morphological characteristics serve that purpose, but also knowledge about the background of the candidate variety, also called "the breeding history", is important in that connection.

Data about the breeding history are required only for the purpose of an efficient examination and are strictly confidential. The TQ, including these data, is no part of the official register. The Board for Plant Breeders' Rights will not inform third parties about the breeding history without authorization of the applicant or his successor in title.

Important data concerning the breeding history are:

Is the candidate variety a mutant and, if so, of which variety?

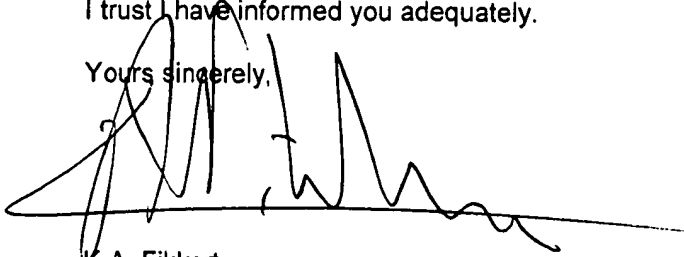
In the case of synthetic or hybrid varieties: which components or inbred lines are involved and which is the formula?

Ad b

Data gained from the official examination are comprised in a variety description. Such descriptions do not contain the breeding history of the varieties concerned. The variety description is included in the official Dutch Variety Register. Since the register is open to the public, third parties can obtain descriptions of the registered varieties. However, through those descriptions they are not informed about the breeding histories.

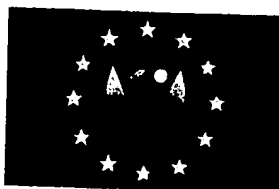
I trust I have informed you adequately.

Yours sincerely,

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke at the end.

K.A. Fikkert,  
Secretary-General





Office Communautaire des Variétés Végétales

**Mrs. Suen-Ying Fung**  
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NL-1430 AJ Aalsmeer

Angers, 10 May 2005

O. ref. : CPVO/ME/ca/500390

**ONTVANGEN 12 MEI 2005**

Dear Mrs Fung,

You have asked the Office to outline how the Office deals with requests for access to documents in general and concerning parent varieties in specific. Please find below my comments to the questions you raised.

*General policy*

As regards the general policy of the Office, there are two sets of rules that govern access to documents and public inspections.

Firstly, Article 88.1 and 2 of Council Regulation 2100/94 states that documents relating to applications and to grants of plant variety rights shall be open for public inspections under certain circumstances. Article 88.3 states that as regards varieties for which material with specific components have to be used repeatedly for the production of material, all data relating to components, including their cultivation, shall be withheld from inspection at the request of the applicant for a Community plant variety right.

Secondly, the European Parliament and Council Regulation (EC) No 1049/2001<sup>1</sup> on public access to documents applies also to documents held by the Office (see Article 33a of Council Regulation 2100/94<sup>2</sup>).

Regulation 1049/2001 applies to all documents held by the Office. Access can only be denied if one of the exceptions laid down in Article 4 applies. The exceptions relate to, *inter alia*, commercial interests including intellectual property rights. The Administrative Council of the Office has adopted practical arrangements on 24 March 2004 describing in more detail the applicable procedure. On the website of the Office, under Access to

<sup>1</sup> Regulation (EC) No 1049/2001 of the European Parliament and of the Council of 30 May 2001 regarding public access to European Parliament, Council and Commission documents

<sup>2</sup> Introduced through the adoption of Council Regulation (EC) No 1650/2003 of 18 June 2003 amending Regulation (EC) No 2100/94 on Community plant variety rights, OJ L245, 29.9.2003, p. 28

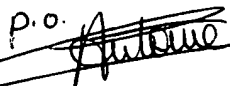
Documents, there is a form to be used for the public when requesting access to documents. You will also find all the legislative provisions mentioned above on this part of the website.

In practice, the Office will grant access to files unless one of the exemptions under Article 4 of Regulation 1049/2001 applies or if the file contains information specified in Article 88.3 of Regulation 2100/94. I encourage you to study the mentioned rules and revert to us should you have any specific questions as regards the procedure.

*Information on parents of varieties*

As already mentioned, Article 88.3 specifies that in case of varieties for which material with specific components has to be used repeatedly for the production of material, at the request of the applicant for a Community plant variety right, all data relating to components, including their cultivation, shall be withheld from inspection. This exemption applies to parent lines needed for the production of a hybrid. The exemption does not apply to chrysanthemum varieties unless the parent lines are used for the production of the protected variety. This is not the case as regards vegetatively reproduced varieties. Apart from information on parent lines needed for the production of material, as just mentioned, the Office does not consider that information on the breeding history could be regarded as confidential neither under Article 4 of Regulation 1049/2001 nor under Article 88.3 of Regulation 2100/94.

Yours sincerely

p.o. 

Martin Ekvad  
Head Legal Affairs